

REMARKSI. Status of the Claims

Claims 1-7, 9-14, 17, 18, 20, 21, and 23-25 are pending in this application, of which Claims 1, 17, and 23 are in independent form. Claims 8, 15, 16, 19 and 22 have been canceled, without prejudice or disclaimer of subject matter. Claims 1 and 17 have been amended. Claims 23-25 are new claims. No new matter has been added, and support for each of the amendments is found in the original specification and claims as discussed below with respect to each claim. Reconsideration of the outstanding rejections is respectfully requested in view of the foregoing amendments and in light of these remarks.

II. Rejections Over The Prior Art

Claims 1-2, 4-7, 9, 11, 13 and 15-17 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,658,963 (Jud); Claims 1-4, 7, 11-14, 17, 19-20 and 22 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,290,526 (Haiss); and Claims 1-4, 7, 9-13, 15-20 and 22 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,934,809 (Marbler).

In addition, the Office Action sets forth a new grounds of rejection alleging that claims 1-2, 15-17 and 22 are anticipated under 35 U.S.C. § 102(a) by WO 98/45127 ("Martel"). As the Examiner did, applicants will cite to the column and line numbers of the United States equivalent (U.S. Patent No. 6,315,480 B1).

### III. Amendments to the Claims

Claim 1 has been amended to recite that the packaging is opened by "bursting" to give access to the product. Support for the amendment is found in the last line of the specification at page 11. Webster's Ninth New Collegiate Dictionary (1984) defines "burst" as follows: "to break open, apart, or into pieces usu. from impact or from pressure from within." The amended language is very close in meaning to "rupture," but more clearly conveys a key concept of the invention: that the gas pressure combined with bending the package causes the bursting.

It is also believed that the amendments address the Examiner's remarks that "the claim specifically states that 'bending the item causes the film to rupture', rather than the gas pressure." (Office Action, page 5; emphasis added). Respectfully, the underlined language is not in the claim, and it has been clear from the words of the claim that the gas pressure combined with bending causes the film to rupture. Thus, the claim stated "...to increase the pressure of the gas to such a point that bending the item causes the film to rupture . . . ." In any event, as amended, claims 1, 17 and 23 are clear that bursting is brought about by increasing the pressure of the gas. The term "bursting" implies that the contents of the container cause the rupture of the packaging along the precut line.

New independent claim 23 is supported by original claims 1 and 4 together with the description at page 6, lines 14-24 and page 10, lines 11-16, as well as Figs. 3-5. Claim 23 recites the orientation of the precut line, which is transverse with respect to the longest dimension of the item, and describes the dimensions of the package in terms of how it is held by the consumer to burst the package. New claims 24 and 25

are respectively supported by original claims 5 and 6, directed to a preferred embodiment wherein the packaging encloses at least two products, with the precut line extending opposite a space between the two products.

#### IV. Argument

##### A. Claimed Item Is Not Inherently Disclosed In The Prior Art

With respect to Jud, Haiss and Marbler, the Office action, in each case, states that "bending inherently caus[es] increased pressure tensioning and an explosive noise" (see paragraphs 3, 4 and 5 of the Office Action). Applicants respectfully submit that this is not the case. The packaging disclosed in Jud, Haiss and Marbler is not configured so that the claimed tensioning and bursting would occur. Further that the law regarding inherent disclosure has not been correctly applied.

The argument that a functional limitation is inherent is appropriate when the functional feature necessarily follows from the structure shown in the prior art. The following cases, which are discussed in the Manual of Patent Examining Procedure at § 2112, are instructive:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the

claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In the present case, the independent claims recite an amount of gas in the package selected so that when the package is bent, the packaging bursts along a precut line. The bursting is clearly distinguished from tearing open a package along a weakened line thereof.

It is highly unlikely that an amount of gas could be selected in a package according to the cited prior art to achieve the claimed effect. Jud Figs. 1-5 clearly show that the packaging is tightly wrapped against the product. The only locations in the packaging where gas could be enclosed are at the two longitudinal ends closed by cross-sealing seams 9, and on the dividing notches 7 of the chocolate bar. However, it is clear from the figures that the enclosed amount of gas at these two locations is very small. Thus, in Jud, it is not possible for the consumer to grasp the packaging "to compress the item so as to increase the pressure of the gas causing the packaging film to be tensioned around the precut line," as presently claimed.

The consumer could try to press with his hands on the longitudinal ends of the packaging so as to drive the corresponding gas out of this location and then drive it with his fingers toward weakness line 3 while trying to enclose the gas between his fingers located on each side of weakness line 3. However, it would be necessary to have one's fingers surround the entire perimeter of the product, to form a sealed enclosure, with one's fingers pressing on the chocolate bar. Further, dividing notches 7 of the

chocolate bar would allow the gas to get back into the longitudinal end locations. Given these considerations, it would not be possible to open the prior art package as presently claimed.

Likewise, the consumer could try to press his fingers into dividing notches 7 so as to drive the corresponding gas towards weakness line 3. But dividing notches 7 are usually very small so that pressing a finger in a notch is impossible. Further, the consumer would face the same difficulties noted above in trying to make this happen: it would not be possible to enclose this little amount of gas in the region of weakening line 3 without surrounding the entire perimeter of the product chocolate bar, and the dividing notches would make it impossible to form a sealed enclosure with one's fingers.

In summary, the consumer could not "increase the pressure" of the gas causing the packaging film to be "tensioned around the precut line," as claimed. The only possible way for the consumer to tension the film around the precut line would be to pull in opposite direction, e.g., the two opposite ends of the packaging. But in this case, tension around the precut line would be provided directly by the pulling strength and not by an increase of gas pressure as presently claimed. As a result, the claimed "amount of gas" is not disclosed inherently by the embodiment of Fig. 1-5 and thus the claims are novel over the embodiment of Figs. 1-5 of Jud.

Further, it is clear from the foregoing that the amount of gas enclosed in the packaging of Figs. 1-5 of Jud does not enable a consumer — regardless of how he grasps the item — to increase the gas pressure to tension the packaging film around weakening line 3 so that bending the item causes the enclosure to open by bursting with the film rupturing instantaneously along the most part of the precut line.

Bending the item of Jud does not cause the packaging to open by bursting along a weakened line because there is no gas present in the region of the weakened line before bending, as the film is relatively tightly wrapped around the product. Bending the item as shown in Fig. 4 and 5 actually increases the interior volume in the region of the precut line, thus causing locally a lowering of the pressure before the packaging film tears. Thus, the packaging of Jud opens due only to the pulling forces on the packaging resulting from the bending action applied on the item, but no bursting occurs as presently claimed, i.e., it is not the pressure within the packaging that causes the packaging to break open. Further, weakening line 3 will not open instantaneously, but progressively along the most part of the precut line unlike in the invention. It is clear that a consumer would never be able to open Jud's packaging by bursting by manipulating the item as recited in present claim 1.

There is also no basis for asserting that the packaging in Jud would produce an explosive noise. According to the claimed invention, the packaging film is inflated and tensioned in the region of the precut line after a consumer grasps it. A subsequent bending action on the item causes pulling strength on the film in the region of the precut line. The combination of the pulling action and the increased internal pressure causes the packaging to open by bursting, the film rupturing instantaneously along the most part of the precut line and resulting in the explosive noise. Without sufficient gas to produce a relatively instantaneous bursting, there would not be an explosive noise obtained. Therefore, for the reasons discussed above, Jud does not anticipate the claims for these additional reasons. Such a combined effect cannot be provided in Jud's

packaging in which weakness line 3 ruptures only due to the pulling force without intervention of an increased internal pressure.

The same considerations apply to the embodiment of Figs. 6 through 9 of Jud and the claims are clearly novel over the embodiments described in these figures as well. Similar considerations also apply to Haiss and Marbler in that there is clearly not an "amount of gas" in the packaging described in these references to cause bursting along a precut line.

For example, Haiss, col. 2, lines 48-49, describes the opening along section 3 as follows: "the flap or tongue 10 is pulled, whereby the package tears along section 3." Thus the tensioning occurs by pulling flap 10, and there is no indication in the reference that this increases the gas pressure around the line 3 to cause bursting, and no evidence that such would inherently be the case.

Marbler, likewise, describes and claims a pouch "including a zone for tearing the pouch open" (claim 1), and the disclosure does not teach or suggest tensioning around a precut line as a result of gas pressure inside the package.

B. Alleged "Intended Use" and "Product-By-Process" Limitations

The Examiner cites Ex Parte Masham, 2 U.S.P.Q.2d 1647 (Bd. Pat. App. & Inter. 1987) for the proposition that "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim".

However, the limitation that has been a key issue throughout the prosecution of this case has been the amount of gas in the packaging. This is an

apparatus limitation. The limitation is not defined in absolute terms (i.e., as a certain number of cc's), but rather in functional terms, i.e., an amount of gas enabling a tensioning and bursting as set forth in the claims and discussed in the remarks above. Clearly, it is permitted to recite an apparatus limitation in functional terms. See M.P.E.P. §§ 2114 and 2173.05(g) and the cases cited therein, including In re Swinehart, 439 F.2d 210 (C.C.P.A. 1971), In re Barr, 444 F.2d 588 (C.C.P.A. 1971) and In re Venezia, 530 F.2d 956 (C.C.P.A. 1976). Applicants respectfully submit that the gas in the packaging is a positive limitation, properly recited in the claims and not found in the prior art, and applicants respectfully request reconsideration of the rejection on these grounds.

The Examiner further refers to product by process limitations. In the present case there are no claims to a product by process, and these remarks are inapposite.

C. Additional Limitations In New Claim 23

New claim 23, in addition to the limitations of claim 1, further recites that the product has a longer dimension, the precut line runs transverse to the longer dimension in a central section of the enclosure. New claim 23 is novel over Jud, Haiss and Marbler for the same reasons as for claim 1. Claim 23 is further novel over Marbler and Haiss because the precut line in these documents does not extend transverse to the longer dimension in a central section of the sealed enclosure. Claim 23 is further novel over Jud because the item of Jud is square, and therefore cannot have a longer dimension.

D. New Grounds Of Rejection

With respect to the new grounds of rejection, Martel does not disclose an enclosure containing a product and an amount of gas, as claimed. In the embodiment of



Figs. 16 and 17, identified in the Office Action, reserve 43 simply contains product, which is pressurized by bending to burst through an aperture (as described at col. 9). Martel teaches "each dose [of fluid product] being contained in a sealed reserve which is defined by an envelope at least partially made of a deformable flexible material, so that a crushing pressure exerted on the reserve causes the envelope to burst in order to release the product contained in the reserve" thereby providing a "flow of product" (see col. 1, line 64 to col. 2, line 6). In contrast, the present claims requires a product and an amount of gas, the gas being pressurized by bending so that the packaging bursts, giving access to the product.

In Martel, pressurized gas does not cause bursting along a precut line, to give access to the product contained in the opened enclosure, as claimed. Rather, Martel discloses a device which ejects the product out of the envelope when the weakness region breaks (see col. 2, lines 6-8; col. 8, lines 10-18; and col. 9, lines 26-31).

In all the embodiments disclosed in Martel, a small aperture bursts, not "along the most part of the precut line," as claimed, and certainly not along a precut line positioned transverse to the longer dimension of the product, etc., as set forth in new claims 23-24.

Martel discloses the presence of a gas, (i.e., air), only for the embodiment of Fig. 21. But, in that case, the air is contained in a separate enclosure with respect to the one containing the fluid product (see col. 4, lines 35-44 and col. 10, lines 30-47). Again, the claims herein require the enclosure to enclose both the product and the gas. In the embodiment of Fig. 21, the air contained in the separate enclosure is not involved in the opening of the enclosure containing the product, but serves only to provide a noise

effect (see col. 4, lines 39-44). Therefore, this embodiment also does not disclose the features set forth in the independent claims.

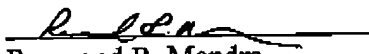
The reference to "hermetically sealed" packaging in Martel suggests a vacuum filled package, and does not implicitly or "inherently" disclose the presence of gas within the sealed enclosure for any of the described embodiments. A perfume package, and the like, contains only product, not additional gas to cause opening of the package. Nothing in Martel leads one of ordinary skill in the art to conclude that gas is present in the packaging. For at least the foregoing reasons, Martel is not considered to anticipate the present claims, and applicants respectfully request that the rejection be withdrawn.

#### CONCLUSION

Applicants respectfully submit that each of the rejections raised in the December 7, 2004 Office Action has been addressed and that the application is now in condition for allowance.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should be directed to our below listed address.

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